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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,497	08/09/2001	Takashi Saga	UDK-001	2619
23353	7590	01/06/2004	EXAMINER	
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

<b>Office Action Summary</b>	Application No. <b>09/924,497</b>	Applicant(s) <b>Saga et al.</b>
	Examiner <b>John Young</b>	Art Unit <b>3622</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1)  Responsive to communication(s) filed on Aug 9, 2001.

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

4)  Claim(s) 1-8 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s).

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

*[Handwritten signatures and initials over the bottom right corner]*  
12-26-2003

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**FIRST ACTION REJECTION**

**DRAWINGS**

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

**CLAIM REJECTIONS — 35 U.S.C. §101**

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8 are rejected under 35 U.S.C. 101, because said claim is directed to non-statutory subject matter.

As per independent claim 1, as drafted said claim is not limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*,

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149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999) within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b).

Note: it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05( q )).

Also, in this case, the claim language is merely non-functional descriptive material disembodied from a concrete tangible and useful result.

Dependent claims 2-8 are rejected for the same reasons as independent claim 1 because said claims depend from claim 1.

#### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set

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forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. §103( a ) as being obvious over Gritzmacher et al. US Pub 2003/0225641 (12/04/2003) [US f/d: 04/11/2003] [**Continuation of US App. 09/536,110; US f/d: 03/24/2000**] (herein referred to as “Gritzmacher”).

As per independent claim 1, Gritzmacher (The ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; ¶ [0044]; ¶ [0052]; and whole document) shows the elements and limitations of claim 1.

Gritzmacher (¶ [0044]) discloses: “*The visual . . . product will be . . . sent over high speed telecommunications lines. . . .*”

Gritzmacher (¶ [0052]) discloses: “*The capability will also exist to electronically insert commercial advertising at the theater before the movie begins. The theater or exhibitor may be able to select specific commercial advertising, using the computer. . . .*”

It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred

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embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989)).

The Examiner interprets the above disclosures of the Gritzmacher reference as reasonably suggesting the elements and limitations of claim 1.

Gritzmacher lacks an explicit recitation of the elements and limitations of claim 1, even though the disclosure of Gritzmacher reasonably suggests same.

It would have been obvious at the time of the invention to a person of ordinary skill in the art that the disclosure of Gritzmacher (The ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; ¶ [0044]; ¶ [0052]; and whole document) would have been selected in accordance with the elements and limitations of claim 1 . . . because selection of such features would have provided means for “generating full motion visual products which is less expensive and more efficient than techniques presently available.” (See Gritzmacher (¶ [0011])).

As per dependent claims 2-8, Gritzmacher shows the method of claim 1 and subsequent base claims depending from claim 1.

Gritzmacher (The ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; ¶ [0044]; ¶ [0052]; and whole document) shows the elements and limitations of claims 2-8; however,

Gritzmacher lacks explicit recitation of the elements and limitations of claims 2-8, even though Gritzmacher reasonably suggests same.

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It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989)).

The Examiner interprets the above disclosures of the Gritzammer reference as reasonably suggesting the elements and limitations of claims 2-8.

It would have been obvious at the time of the invention to a person of ordinary skill in the art that the disclosure of Gritzammer (The ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; ¶ [0044]; ¶ [0052]; and whole document) would have been selected in accordance with the elements and limitations of claims 2-8 . . . because selection of such features would have provided means for “generating full motion visual products which is less expensive and more efficient than techniques presently available.” (See Gritzammer (¶ [0011])).

## CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents  
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Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

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(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

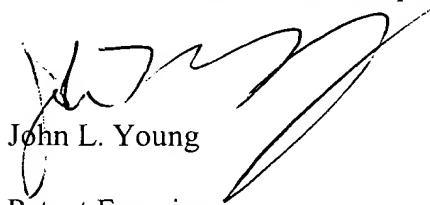
Hand delivered responses may be brought to:

Seventh Floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young

Patent Examiner

December 26, 2003